

## **REMARKS**

Claims 1-12 are pending in the application. In the Office action dated November 21, 2008, claims 1-12 were rejected. In view of the amendments above, and the remarks below, Applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

### ***Objections to the Claims***

The Examiner has objected to dependent claims 2-4 and 6-12 because they refer to "A method" according to a previous claim instead of "The method" according to a previous claim.

Applicants respectfully suggest that this is not a "claim drafting error", as suggested by the Examiner. The dependent claims clearly define the claimed subject matter, and unambiguously refer to the claim from which they depend. Applicants are unaware of an authority which requires the use of "A" and "The" as suggested by the Examiner.

However, in the interest of facilitating the prosecution of the application, Applicants have amended claims 2-4 and 6-12 as requested by the Examiner. In view of the amendments, Applicants request the withdrawal of the objection to those claims.

### ***Rejections under 35 U.S.C. § 112***

Claims 4 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner suggests that the term "heavy" is a relative term that renders the claim indefinite. Applicants respectfully

disagree.

Applicants suggest that the definiteness of the claim language used must be evaluated in view of a) The content of the disclosure; b) The teachings of the prior art; and c) The interpretation that would be given by one of ordinary skill in the pertinent art at the time the invention was made (see MPEP § 2173.02). In this instance, the phrase "heavy ballast" has been used in the maritime arts to refer to ballast that is heavier than water. This meaning is consistent with the use of the phrase "heavy ballast" in the specification at page 6, line 33 to page 7, line 10.

In fact the phrase "heavy ballast" has had this meaning, and been in use in the maritime arts for a considerably long time. William Falconer's Dictionary of the Marine, published 1780, states that "Stiffness in ballasting is occasioned by disposing a great quantity of *heavy ballast*, as lead, iron, &c. in the bottom, which naturally places the center of gravity very near the keel" (Thomas Cadell's new corrected edition, London: 1780, page 28, 2004; emphasis added). More recently, U.S. Patent no. 4,759,307 to Scott (1988) states that:

"In the tanks which are dedicated to ballast, a ballast material (heavy ballast) of higher density than seawater is placed to occupy a portion of the volume of the tank. The remainder of the tank is used for water ballast in the usual manner." (at col. 1, lines 64-68; emphasis added; copy enclosed).

Applicants respectfully suggest that one of skill in the art of maritime architecture would be well aware of the meaning of a phrase used for more than the last 200 years.

In view of the above remarks, Applicants respectfully suggest that claims 4 and 8

particularly point out and define the claimed subject matter, and therefore they request the withdrawal of the rejection of claims 4 and 8 under 35 U.S.C. § 112, second paragraph.

***Rejections under 35 U.S.C. § 102***

Claims 1-3, 5-7, 11 and 12 are rejected under 35 U.S.C. § 103(e) as being anticipated by Vatsvag (U.S. Patent Publication no. 2004/0258483). Applicants respectfully disagree.

Claim 1 recites a method for removing an offshore jacket structure that includes:

(a) providing a ballastable vessel that has a main buoyancy section that is generally horizontal in the normal floating condition of the vessel, and has two auxiliary buoyancy sections above and on either side of the main buoyancy section in the normal floating condition;

(b) bringing the vessel into the vicinity of the jacket structure;

(c) ballasting the vessel in order to rotate the main section to an approximately vertical condition and bringing the main section into contact with the jacket structure, so that the auxiliary buoyancy sections are located on opposite sides of the jacket structure;

(d) securing the vessel to the jacket structure and de-ballasting the vessel so as to raise the vessel with the jacket structure to the water surface while rotating the main section back to the generally horizontal position.

The claimed method is characterized in that in step (c) the main section is at first rotated less than 90° from the horizontal, then it is lowered so that its lower end rests on the seabed adjacent to the jacket structure, where it is rotated beyond 90° into contact with the jacket structure while its lower end is in contact with the seabed.

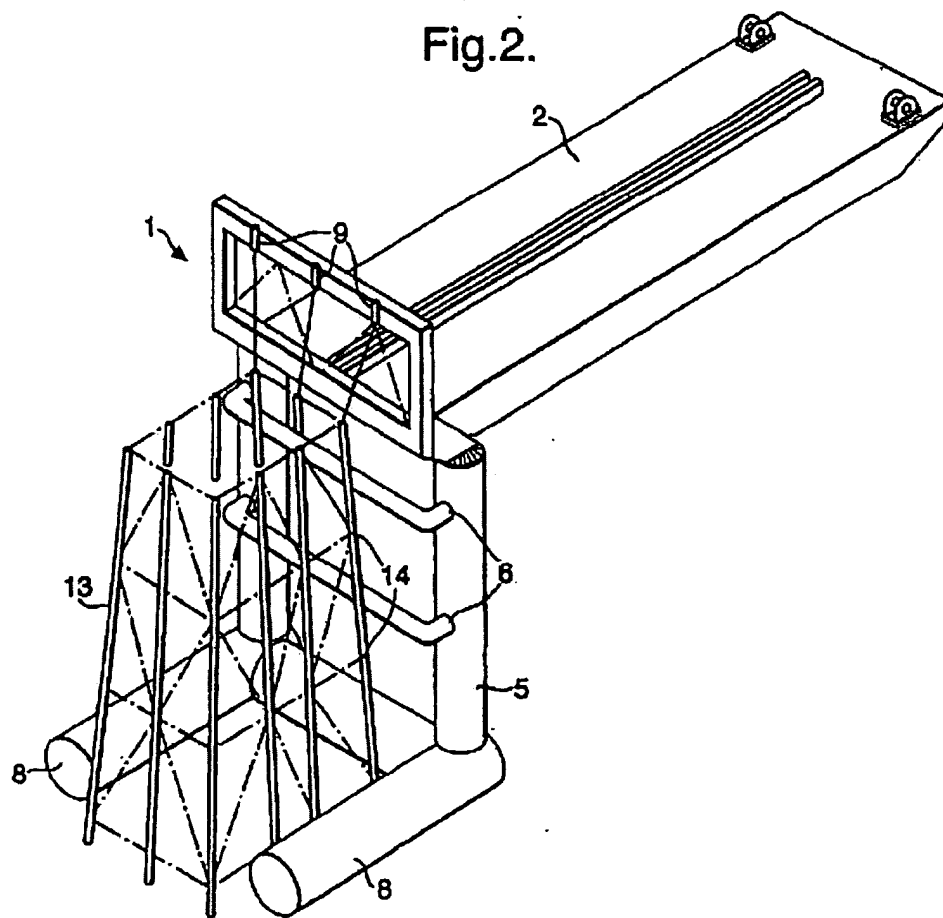
In the previous response, Applicant argued that at no time does the vessel of Vatsvag, or the main flotation chamber of the vessel of Vatsvag, become ballasted; that at no time does the vessel deviate from being horizontal on the surface of the water; and that at no time is the vessel of Vatsvag lowered until the lower end is resting on the sea floor.

Additionally, the Applicant previously noted that the use of a single vessel in the claimed method offers several advantages. Specifically that when the vessel is in position to be connected to the jacket structure, it presents a small waterline area and is therefore not likely to be subjected to disturbances from waves and swell, and furthermore that the buoyancy of the vessel need not be much larger than what is necessary to carry the jacket structure, keeping its steel weight and construction cost to a minimum.

Applicant has specifically pointed out that the vessel of Vatsaq (and therefore the method of Vatsaq) is distinct from that of claim 1 in that the vessel of Vatsvag uses a pivotable frame, rather than rotating and ballasting the entire vessel. This means that the vessel of Vatsvag is at all times subject to wave motion, wind and current along its entire waterline, rendering the coupling of the frame to the jacket structure more difficult. Furthermore, the additional size and complexity of the Vatsvag vessel render it not only more complicated to operate, but requires greater buoyancy, and steel weight (with its accompanying cost) than is necessary to carry the jacket structure.

In response, the Examiner has asserted that "element 1 of the prior art has been identified as the vessel in the above rejection". To be specific, rather than construing the

vessel 2 of Vatsag to be a vessel, the Examiner suggests that pivotable arm 1 is a "vessel" for the purposes of rejecting the claims. Arm 1 and its pivotable connection to vessel 2 is shown in Fig. 2 of Vatsag, below:



Applicant traverses the rejection, and suggests that the Examiner is employing an improper standard of examination in applying the rejection under 35 U.S.C. § 102.

As indicated at MPEP § 2111, during examination the examiner should give the pending claims their "broadest reasonable interpretation". However, under the guidelines provided by the MPEP and by the Federal Circuit, the Examiner is not permitted to examine the claim using the broadest interpretation the Examiner can envision. Rather, the Examiner's interpretation must remain consistent with the ordinary meaning of the words used, the plain language of the claim, the totality of the written description, and the meaning as they would be understood by one of ordinary skill in the art (see for example *In re Baker Hughes Incorporated*, 215 F.3d 1297; 55 USPQ2d 1149 (CAFC, 2000) and *In re Joyce A. Cortright*, 165 F.3d 1353; 49 USPQ2d (CAFC 1999); copies enclosed).

Claim 1 is directed to a method that utilizes a "ballastable vessel." The vessel of the claimed method is capable of being ballasted to bring it into an approximately vertical condition, lowered so that its lower end rests on the seabed, secured to the jacket structure, then de-ballasted to raise the vessel with the jacket structure to the surface of the water. In the specification, the Applicant refers to providing a vessel that can "approach the jacket structure in a safe and controlled manner also under inclement weather conditions, while the shape of the vessel is such that it has little excess buoyancy and is easy to build with common shipyard technology and equipment" (page 1, line 31 to page 2, line 2).

The vessel of the disclosure is shown in Figure 1, reproduced below:

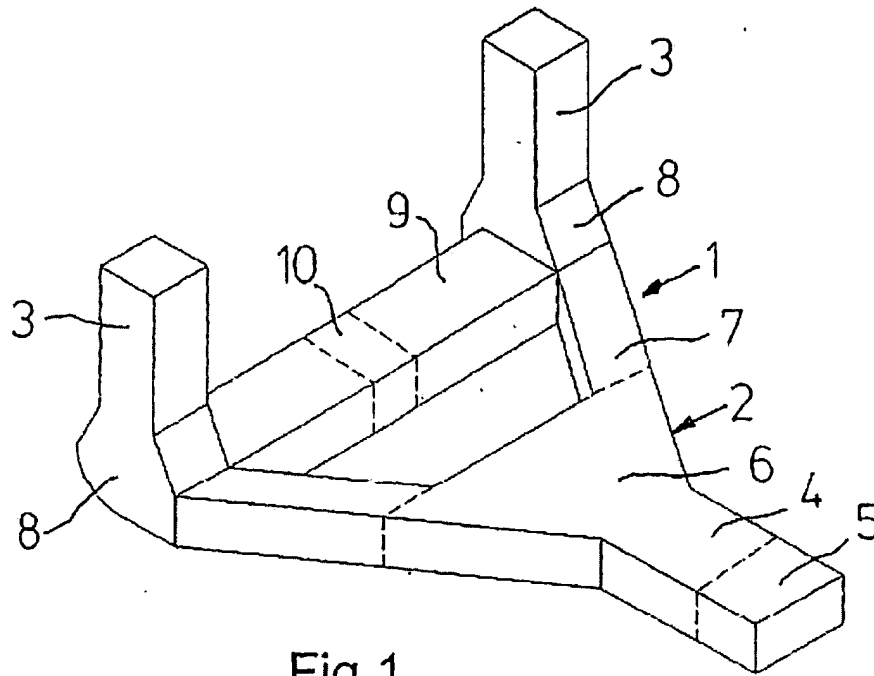


Fig 1

Vessel 1 is described as including a generally planar, ballastable main buoyancy section 2, two auxiliary buoyancy sections 3, and a rectangular box section 4, also labeled the nose section, where forward part 5 serves as reserve buoyancy will always be above the still water level (see the specification at page 2, lines 14-30). Applicant's use of the term "vessel" is perfectly consistent with the ordinary meaning of the word, and the meaning that would be understood by one of ordinary skill in the nautical arts. For example, the American Heritage Dictionary of the English Language: Fourth Edition (2000) gives a definition of "vessel" as "a craft, especially one larger than a rowboat, designed to navigate on water."

Applicant suggests that the pivotable arm of Vatsvag is neither a craft, nor is it designed to navigate on water. One of ordinary skill in the art would not consider the pivotable arm 1 of Vatsvag to be a vessel.

In view of the remarks above, Applicant suggests that the Examiner's interpretation of the term "vessel" in claim 1 is improper, that the Examiner's interpretation of the teaching of Vatsvag is improper, and that the method of claim 1 is neither disclosed nor suggested by the Vatsvag reference, and therefore the rejection of claim 1 under 35 U.S.C. § 102 should be withdrawn. As claims 2, 3, 11 and 12 depend from claim 1, Applicant suggest they are similarly not anticipated by Vatsvag.

With respect to claim 5, the claimed vessel is similarly not anticipated by Vatsvag. As discussed previously, the claimed vessel includes a ballastable main buoyancy section and two auxiliary buoyancy sections protruding in the same direction on either side of the main section, such that the main buoyancy section is generally planar and has (in plan view) substantially the outline of an isosceles triangle with an extension at the apex, where the extension forms the fore part of the vessel, and the base of the triangle forms the aft part of the vessel, with the auxiliary sections located at the ends of the base of the triangle. The vessel of Vatsvag in no way defines an isosceles triangle.

The Examiner has suggested that "features upon which applicant relies (i.e., the vessel having the general shape of an isosceles triangle as seen from plan view) are not recited in the rejected claim(s)". Applicant respectfully disagrees. Claim 5 is directed to a vessel having a main buoyancy section that is "generally planar and has in plan view substantially the outline of an isosceles triangle with an extension at the apex" (emphasis added).



In view of the remarks above, Applicant respectfully suggests that the "vessel" of Vatsvag is distinct from that of claim 5, and that the Vatsvag reference fails to disclose each and every element of claim 5. Applicant therefore respectfully requests the withdrawal of the rejection of claim 5 under 35 U.S.C. § 102. As claims 6 and 7 depend from claim 5, Applicant suggests they are similarly not anticipated by the reference, and the rejection of claims 6 and 7 should also be withdrawn.

***Rejections under 35 U.S.C. § 103***

Claims 4 and 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vatsvag (U.S. Patent Publication no. 2004/0258483). Applicant traverse the rejection.

As discussed above, Applicant respectfully suggests that the Vatsvag reference fails to anticipate claims 1 and 5. Vatsvag therefore fails to disclose each and every element of claims 1 and 5. As claims 4 and 8-10 depend from claims 1 and 5, respectively, Vatsvag fails to disclose each and every element of claims 4 and 8-10, therefore Vatsvag necessarily fails to establish the *prima facie* obviousness of claims 4 and 8-10.

In view of the above remarks, Applicant respectfully requests the withdrawal of the rejection of claims 4 and 8-10 under 35 U.S.C. § 103.

Applicant believes that in view of the above amendments and remarks, the application is in condition for allowance. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

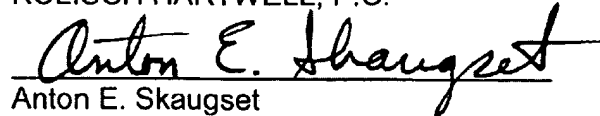
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